

## REMARKS

Claims 1-49 are pending in the present application. Claims 1-20, 22-24, 26, 31-32, 34-36 and 38-40 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,649,296 to MacLellan (the MacLellan patent) in view of U.S. Patent No. 5,493,437 to Lebby et al. (the Lebby patent) and U.S. Patent No. 5,245,329 to Gokcebay (the Gokcebay patent). Claims 21, 25, 33, 37 and 41 stand rejected under 35 U.S.C. §103(a) for obviousness over the MacLellan patent in view of the Lebby patent and Gokcebay patent and further in view of U.S. Patent No. 4,461,793 to Blok et al. (the Blok patent). Claims 27-29 stand rejected under 35 U.S.C. §102(b) for anticipation by U.S. Patent No. 5,462,374 to Kohno (the Kohno patent). Claim 30 stands rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of the MacLellan patent. Claims 42-49 stand rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of U.S. Patent No. 5,166,680 to Ganot (the Ganot patent).

Applicant respectfully traverses the rejections and urges allowance of the present application.

Non-analogous art areas cannot properly be combined for an obviousness rejection where the problems addressed by each are non-analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986.) A field of art is analogous *only* if one seeking the solution in one art area would be likely to seek the solution by referring to the

1 other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225  
2 USPQ 634 (Fed. Cir. 1985).

3 The teachings of the Gokcebay patent have been improperly  
4 combined with the teachings of the MacLellan patent and the Lebby  
5 patent to establish the obviousness rejections. In particular, the  
6 combination of non-analogous art areas is precluded by long standing  
7 Federal Circuit precedent. Prior art references are only analogous if the  
8 reference is in the field of Applicant's endeavor or the reference is  
9 reasonably pertinent to the particular problem with which the inventor  
10 was concerned. MPEP §2145(i) (citing *In re Oetiker*, 977 F.2d 1443, 24  
11 USPQ2d 1443, 1445 (Fed. Cir. 1992)).

12 Referring to the rejection of independent claim 1, it is stated on  
13 pages 5 and 6 of the Office Action that the Gokcebay patent teaches  
14 the desire of an access control system that comprises a key having a  
15 side with visibly perceptible information thereon and the dimension of  
16 the side being less than the smallest dimensions of the upper and lower  
17 surfaces for the purpose of carrying information relating to a personal  
18 authenticating feature of the intended user of the key.

19 Referring to the above standards set forth by the Federal Circuit,  
20 it is clear that the Gokcebay patent comprises art non-analogous to  
21 Applicant's invention as well as the MacLellan and Lebby patents.  
22 Independent claim 1 defines a remote intelligent communication device  
23 comprising, in part, a card-thin housing and communication circuitry  
24 within the housing configured to at least one of communicate and

1 receive electronic signals. The MacLellan patent further relates to  
2 communication devices.

3 To the contrary, the Gokcebay patent relates to access control  
4 systems with mechanical keys which store data. As stated in the  
5 Abstract of the Gokcebay patent, the access control system includes a  
6 series of keys having encoded data stored on the bottom edges of the  
7 keys.

8 Independent claim 1 is clearly directed to communication devices  
9 configured to at least one of communicate and receive electronic signals.  
10 The Gokcebay patent is directed to access control systems, such as for  
11 example, access for a door, gate, drawer, safe, safety deposit box,  
12 computer terminal or other situation wherein high security is desirable  
13 as stated in the Abstract of the Gokcebay patent. Clearly, the problems  
14 in both art areas are different from one another. A person of skill in  
15 remote communication device art or radio frequency identification  
16 device (RFID) art would in no way think of looking at security or  
17 access art to find meaningful teachings.

18 Accordingly, application of the Gokcebay patent in an obviousness  
19 rejection of Applicant's claim 1 is inappropriate for at least this reason.  
20 The rejection of independent claim 1 in view of the Gokcebay patent  
21 is contrary to long-standing Federal Circuit precedent cited above.  
22 Applicant respectfully requests the withdrawal of the obviousness  
23 rejection for at least this reason.  
24

1           The utilization of the Gokcebay patent in the subject obviousness  
2 rejection of Applicant's claims is also improper for lack of suggestion  
3 or teaching to combine the references. Referring to MPEP §2146(j)(3),  
4 there must be some suggestion or motivation, either in the references  
5 themselves or in the knowledge generally available to one of ordinary  
6 skill in the art, to modify or combine reference teachings. The mere  
7 fact that references *can* be combined or modified does not render the  
8 resultant combination obvious *unless the prior art also suggests the*  
9 *desirability of the combination.* MPEP §2143.01 citing *In re Mills*, 916  
10 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

11           Obviousness cannot be established by a combination of references  
12 unless there is some motivation in the art to support the combination.  
13 (*See ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577,  
14 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established  
15 by combining the teachings of the prior art to produce the claimed  
16 invention, absent some teaching, suggestion or incentive supporting the  
17 combination.")). The motivation for forming the combination must be  
18 something other than hindsight reconstruction based on using Applicant's  
19 invention as a road map for such a combination. *See, e.g., Interconnect*  
20 *Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re*  
21 *Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight  
22 reconstruction is an improper basis for rejection of a claim).

23           Evidence of a suggestion to combine may flow from the prior art  
24 references themselves, from the knowledge of one skilled in the art, or

1 from the nature of the problem to be solved. However, this range of  
2 sources does not diminish the requirement for actual evidence. Further,  
3 the showing *must be clear and particular*. See *In re Dembiczak*,  
4 No. 98-1498 (Fed. Cir. 4/28/99).

5 On page 6 of the Office Action, features of the respective  
6 MacLellan, Lebby and Gokcebay patents are recited. In fact, *only*  
7 *features* of the references which purportedly correspond to limitations of  
8 Applicant's claims are discussed. The Office Action cites no teaching,  
9 suggestion or motivation to combine the teachings of the Gokcebay  
10 patent with the other references. Evidence of the suggestion to combine  
11 the references *must be clear and particular*. The record is entirely devoid  
12 of any suggestion to combine the references, let alone any clear or  
13 particular suggestion to combine the references in support of the  
14 obviousness rejection of claim 1. Without any such teaching or  
15 suggestion, the rejection of claim 1 is merely hindsight reconstruction  
16 proscribed by the Federal Circuit. Independent claim 1 is in condition  
17 for allowance for this additional reason.

18 Further, the Office Action cites a total of some three references  
19 against Applicant's claim 1. The fact that the so many references were  
20 combined in an attempt to show that Applicant's claimed invention is  
21 "obvious" illustrates exactly why the invention is *not* obvious. There is  
22 simply nothing like, or suggestive, of Applicant's claim 1 invention in the  
23 prior art. Small pieces of the claimed invention have been allegedly  
24 located scattered amongst a combination three references. *A person of*

1     *ordinary skill in the art would not combine the cited three teachings.* The  
2     large number of cited references makes the rejection of claim 1 tenuous  
3     in the extreme. Applicant respectfully requests allowance of claim 1 for  
4     the above numerous reasons.

5             Claims 2-5 depend from independent claim 1 and therefore are in  
6     condition for allowance for the reasons discussed above with respect to  
7     claim 1 as well as for their own respective features which are neither  
8     shown nor suggested by the cited art.

9             Referring to the rejection of independent claim 6, the Gokcebay  
10    patent comprises non-analogous art to Applicant's invention. Accordingly,  
11    such is not properly combinable to support an obviousness rejection of  
12    independent claim 6. Applicant requests withdrawal of the obviousness  
13    rejection for this reason alone.

14            Further, there is absolutely no motivation or suggestion to combine  
15    the references in the manner provided in the rejection of claim 6. The  
16    obviousness rejection of independent claim 6 is improper for this  
17    additional reason. Applicant respectfully requests withdrawal of the  
18    obviousness rejection. Applicant requests allowance of claim 6.

19            Claims 7-12 depend from independent claim 6 and therefore are  
20    in condition for allowance for the reasons discussed above with respect  
21    to claim 6 as well as for their own respective features which are neither  
22    shown nor suggested by the cited art.

23            The Gokcebay patent comprises non-analogous art to Applicant's  
24    invention. Accordingly, such is not properly combinable to support an

1 obviousness rejection of independent claim 13. Applicant requests  
2 withdrawal of the obviousness rejection of claim 13 for this reason  
3 alone.

4 Further, there is no motivation or suggestion to combine the  
5 references in the manner provided in the rejection of claim 13. The  
6 obviousness rejection of independent claim 13 is improper for this  
7 additional reason. Applicant respectfully requests withdrawal of the  
8 obviousness rejection. Applicant requests allowance of claim 13.

9 Claims 14-18 depend from independent claim 13 and therefore are  
10 in condition for allowance for the reasons discussed above with respect  
11 to claim 13 as well as for their own respective features which are  
12 neither shown nor suggested by the cited art.

13 Claim 19 stands rejected for obviousness in view of the Gokcebay  
14 patent. The Gokcebay patent comprises non-analogous art to Applicant's  
15 invention and is not properly combinable to support an obviousness  
16 rejection. Applicant requests withdrawal of the obviousness rejection of  
17 claim 19 for this reason alone.

18 There is no motivation or suggestion to combine the references in  
19 the manner provided in the rejection of claim 19. The obviousness  
20 rejection of independent claim 19 is improper for this additional reason.  
21 Applicant requests allowance of claim 19.

22 Claims 20-22 depend from independent claim 19 and therefore are  
23 in condition for allowance for the reasons discussed above with respect  
24

1 to claim 19 as well as for their own respective features which are  
2 neither shown nor suggested by the cited art.

3 Claim 23 stands rejected for obviousness in view of the Gokcebay  
4 patent. The Gokcebay patent comprises non-analogous art to Applicant's  
5 invention and is not properly combinable to support an obviousness  
6 rejection. Further, there is no motivation or suggestion to combine the  
7 references in the manner provided in the rejection of claim 23. The  
8 obviousness rejection of independent claim 23 is improper for these  
9 reasons. Applicant requests allowance of claim 23.

10 Claims 24-26 depend from independent claim 23 and therefore are  
11 in condition for allowance for the reasons discussed above with respect  
12 to claim 23 as well as for their own respective features which are  
13 neither shown nor suggested by the cited art.

14 Referring to the rejection of claim 27 under 35 U.S.C. §102(b),  
15 the PTO and Federal Circuit provide that §102 anticipation requires that  
16 *each and every element* of the claimed invention be disclosed in a single  
17 prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed.  
18 Cir. 1990). The corollary of this rule is that the absence from a  
19 cited §102 reference of *any* claimed element negates the anticipation.  
20 *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81  
21 (Fed. Cir. 1986).

22 Independent claim 27 defines a method of forming a card  
23 comprising, in part, providing a card including an upper surface, a lower  
24



1 surface and a plurality of sides, the sides individually having a dimension  
2 less than the smallest dimensions of the upper and lower surfaces.

3 Referring to the Kohno patent, a card having reference numeral 1  
4 and a print head having reference numeral 4 are disclosed in Fig. 1 and  
5 Fig. 4. The Kohno patent as clearly illustrated in Fig. 1 and Fig. 4  
6 *discloses moving either an upper surface or a lower surface of the card and*  
7 *the print head relative to one another. The print head is disclosed as*  
8 *printing upon one of the upper and lower surface of the card.* The Kohno  
9 patent fails to teach or suggest printing visibly perceptible information  
10 on at least one side of the card as claimed. Claim 27 is allowable for  
11 at least this reason.

12 Further, Applicant specifically defines sides individually having a  
13 dimension less than the smallest dimensions of the upper and lower  
14 surfaces in claim 27. Such is not shown nor suggested in the prior art.  
15 The surface printed upon by print head 4 does not have a dimension  
16 less than the disclosed sides of the card 1 in the Kohno patent.  
17 Accordingly, positively cited limitations within claim 27 have been utterly  
18 ignored in formulating the anticipation rejection of independent claim 27.  
19 In view of the above authority, the rejection of claim 27 is improper  
20 for at least this reason. Applicant respectfully requests withdrawal of  
21 the anticipation rejection.

22 In addition, the prior art of record including the Kohno patent  
23 fails to suggest provision of the method of forming a card as defined  
24

1 in independent claim 27. Independent claim 27 is in condition for  
2 allowance.

3 The Office Action, at page 3, states the Kohno patent discloses  
4 cards individually having a side with a dimension less than the smallest  
5 dimensions of the upper and lower surfaces. However, there is no  
6 teaching or suggestion in the Kohno patent to encode visibly perceptible  
7 information on the side of the card as defined in claim 27. Claim 27  
8 is patentable over the Kohno patent.

9 Claims 28-30 depend from independent claim 27 and therefore are  
10 in condition for allowance for the reasons discussed above with respect  
11 to claim 27 as well as for their own respective features which are  
12 neither shown nor suggested by the cited art.

13 Claim 31 stands rejected for obviousness in view of the Gokcebay  
14 patent. The Gokcebay patent comprises non-analogous art to Applicant's  
15 invention and is not properly combinable to support an obviousness  
16 rejection. Applicant requests withdrawal of the obviousness rejection of  
17 claim 31 for this reason alone.

18 There is no motivation or suggestion to combine the references in  
19 the manner provided in the rejection of claim 31. The obviousness  
20 rejection of independent claim 31 is improper for this additional reason.  
21 Applicant requests allowance of claim 31.

22 Claims 32-33 depend from independent claim 31 and therefore are  
23 in condition for allowance for the reasons discussed above with respect  
24

1 to claim 31 as well as for their own respective features which are  
2 neither shown nor suggested by the cited art.

3 Claim 34 stands rejected for obviousness in view of the Gokcebay  
4 patent. The Gokcebay patent comprises non-analogous art to Applicant's  
5 invention and is not properly combinable to support an obviousness  
6 rejection. Further, there is no motivation or suggestion to combine the  
7 references in the manner provided in the rejection of claim 34. The  
8 obviousness rejection of independent claim 34 is improper for these  
9 reasons. Applicant requests allowance of claim 34.

10 Claims 35-38 depend from independent claim 34 and therefore are  
11 in condition for allowance for the reasons discussed above with respect  
12 to claim 34 as well as for their own respective features which are  
13 neither shown nor suggested by the cited art.

14 Applicant has amended claim 39 to define the solid housing having  
15 a housing thickness with a dimension less than smallest dimensions of  
16 the upper and lower surfaces. Claim 39 is patentable over the prior  
17 art.

18 Claim 39 stands rejected for obviousness in view of the Gokcebay  
19 patent. The Gokcebay patent comprises non-analogous art to Applicant's  
20 invention and is not properly combinable to support an obviousness  
21 rejection. Further, there is no motivation or suggestion to combine the  
22 references in the manner provided in the rejection of claim 39. The  
23 obviousness rejection of independent claim 39 is improper. Applicant  
24 requests allowance of claim 39 for these reasons.

1           Claims 40-41 depend from independent claim 39 and therefore are  
2 in condition for allowance for the reasons discussed above with respect  
3 to claim 39 as well as for their own respective features which are  
4 neither shown nor suggested by the cited art.

5           Referring to the obviousness rejection of claim 42, the Ganot  
6 patent also comprises non-analogous art to Applicant's invention. The  
7 Ganot patent relates to a portable parking meter device and method of  
8 operating the same. Such is clearly non-analogous to remote intelligent  
9 communication devices or radio frequency identification devices (RFID).  
10 The rejection of independent claim 42 is improper for at least this  
11 reason.

12           Additionally, there is no teaching, motivation or suggestion to  
13 combine the references in support of the obviousness rejection of  
14 claim 42. The obviousness rejection of claim 42 is improper for this  
15 reason alone.

16           Even if the teachings of the references are combined as set forth  
17 in the Office Action, such combined teachings of the references do not  
18 support an obviousness rejection of claim 42. An obviousness rejection  
19 requires consideration of all the elements of the claimed invention.  
20 Further, all such elements must be shown to be suggested by the prior  
21 art when making a rejection based upon obviousness under 35  
22 U.S.C. §103(a). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.  
23 Cir. 1987). The test for obviousness is what the combined teaching of  
24 the references would have suggested to those of ordinary skill in the

1 art. *In re Keller*, 642 F.2d 413, 208 USPQ 871, 881 (CCPA 1981),  
2 MPEP §2145(c).

3 The Kohno patent fails to teach or suggest encoding indicia upon  
4 a *side surface* as claimed. Further, none of the cited prior art  
5 references disclose the encoding of identification indicia as claimed.  
6 Applicant has cited limitations in claim 42 not disclosed or suggested in  
7 the prior art references. Accordingly, even if the prior art references  
8 are improperly combined, such combination does not render obvious  
9 Applicant's claim 42. Claim 42 is in condition for allowance for the  
10 above numerous reasons.

11 Applicant notes the Office Action on pages 2-3 includes numerous  
12 responses to Applicant's previously asserted points in the Amendment  
13 dated May 14, 1999. Two of the previously asserted points in the  
14 Amendment asserted that the Ganot patent comprises non-analogous  
15 subject matter and there is no motivation, teaching or suggestion to  
16 support the combination of references made in the obviousness  
17 rejections. The numerous responses in the Office Action dated  
18 August 3, 1999 fail to address these points. Applicant respectfully  
19 requests comment on these points in the event such current obviousness  
20 rejections of Applicant's claims are maintained.

21 Claims 43-45 depend from independent claim 42 and therefore are  
22 in condition for allowance for the reasons discussed above with respect  
23 to claim 42 as well as for their own respective features which are  
24 neither shown nor suggested by the cited art.

1 Referring to the obviousness rejection of claim 46, the Ganot  
2 patent comprises non-analogous art to Applicant's invention and as such  
3 is not a proper reference to support the obviousness rejection. The  
4 rejection of independent claim 46 is improper for at least this reason.

5 Further, there is no teaching, motivation or suggestion to combine  
6 the references in support of the obviousness rejection of claim 46. The  
7 obviousness rejection of claim 46 is improper for this additional reason.

8 In addition, none of the cited prior art references disclose the  
9 encoding of identification indicia on a *side surface* as claimed. Applicant  
10 has cited limitations in claim 46 not disclosed or suggested in the prior  
11 art references. Accordingly, even if the prior art references are  
12 improperly combined, such combination does not render obvious  
13 Applicant's claim 46. Claim 46 is in condition for allowance for the  
14 above numerous reasons.

15 Claims 47-49 depend from independent claim 46 and therefore are  
16 in condition for allowance for the reasons discussed above with respect  
17 to claim 46 as well as for their own respective features which are  
18 neither shown nor suggested by the cited art.

19 Applicant respectfully requests allowance of all pending claims.

20 The Examiner is requested to phone the undersigned if the  
21 Examiner believes such would facilitate prosecution of the present  
22  
23  
24

1 application. The undersigned is available for telephone consultation at  
2 any time during normal business hours (Pacific Time Zone).  
3

4 Respectfully submitted,

5  
6 Dated: 11/3/99

By: 

James D. Shaurette  
Reg. No. 39,833  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24